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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,202	12/27/2001	Frans Eduard Janssens	JANS-0027	9001

7590 03/15/2004

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EXAMINER

HABTE, KAHSAI

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 03/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/030,202

Applicant(s)

JANSSENS ET AL.

Examiner

Kahsay Habte, Ph. D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6,8-10,13-15 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9 is/are allowed.
- 6) ☒ Claim(s) 1-4,10,13,15 and 18-21 is/are rejected.
- 7) ☒ Claim(s) 6, 8 and 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-4, 6, 8-10, 13-15 and 18-21 are pending.

Response to Amendment

2. Applicant's amendment filed 02/04/2004 in response to the previous Office Action (Paper No. 13) is acknowledged. Rejections of claims 1-4, 6, 8-15 and 18-21 under 35 U.S.C. § 112, first and second paragraph (Paper No. 13, paragraphs 5 and 6a-6c) have been obviated. The prior art rejection under 102(b) rejection is also obviated. The obviousness rejection under 103(a) is maintained.

Allowable Subject Matter

3. Claims 6, 8 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 9 is allowed.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-4, 10, 13, 15 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Janssens et al. (US Pat No. 5,360,807). The reference discloses compounds such as 1-[(6-methyl-2-pyridinyl)methyl]-2-(4-piperidinyloxy)-1H-Benzimidazole; 1-[(6-methyl-2-pyridinyl)methyl]-2-(4-piperidinylmethyl)-1H-Benzimidazole, which has been excluded from the instant claims, see the last line of claim 2. The instant claims, however, include compounds that are homologues of the reference compounds, i.e., compounds that differ by a -CH₂ group (i.e., adding or removing a methyl substituent to or from the reference compounds, e.g., adding a -CH₂- group to the pyridyl substituent to the species 1-[(6-methyl-2-pyridinyl)methyl]-2-(4-piperidinyloxy)-1H-Benzimidazole. The reference teaches that the compound is useful as an active antiallergic and antihistaminic agent for the treatment of warm-blooded animals suffering from allergic diseases. One having ordinary skill in the art would have been motivated to prepare the instantly claimed compounds because such structurally homologous compounds would be expected to possess similar utilities. It has been held that compounds that are structurally homologous to prior art compounds are prima facie obvious, absent a showing of unexpected results. *In re Haas*, 60 USPQ 544 (CCPA 1944); *In re Henze*, 85 USPQ 261 (CCPA 1950). *In re Dillon*, 919 F.2d at 696, 16 USPQ2d at 1904 (Fed. Cir. 1990).

Response to arguments

Applicant's argument filed 02/04/2004 has been fully considered but it is not persuasive.

Applicants argue that the Office did not establish a prima facie case and cited a case law (*In re Grabiak*, 769 F. 2d 729, 733, 226 USPQ 870, 873 (Fed. Cir. 1983), but the examiner disagrees with applicants. The Office has provided prima facie case by citing cases laws and clearly indicates the motivation (see above). Applicants also argue "US-A-5,360,807 discloses the use of its compounds in methods of treating warm-blooded animals suffering from allergic diseases, whereas the claimed invention is directed to compounds useful in methods for treating respiratory syncytial viral infections." Applicants further argue: "[t]here is no established connection between the treatment of allergic diseases and the treatment of respiratory syncytial viral infections." The examiner disagrees with applicants, since this is just a speculation. Applicant's conclusory statement must be supported by evidence. As far as we know, the prior art compound can also be used for the treatment of respiratory syncytial viral infections, since it has all the inherent characteristics. Applicants can overcome the rejection by showing that the prior art compound cannot be used for the treatment of respiratory syncytial viral infections, by doing simple tests.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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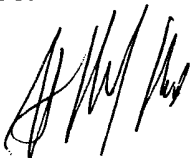
shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte, Ph. D. whose telephone number is (571) 272-0667. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on (571) 272-0674 or if there is no response within 24 hours call James Wilson on (571) 272-0661. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



Kahsay Habte, Ph. D.
Examiner
Art Unit 1624



DEEPAK RAO
PRIMARY EXAMINER

for

Mukund J. Shah
Supervisory Patent Examiner
Art Unit 1624

KH
March 11, 2004